

REMARKS

Applicants reply to the Office Action mailed on May 6, 2005, within the shortened three-month period for reply. Claims 1-47 were pending in the application and the Examiner rejects claims 1-47. Applicants amend claims 1-2, 4, 6-10, 12, 15-16, 19-27, 29-41, 44-47 and add new claims 48-49. Applicants cancel claims 11, 13-14, 28 and 43 without prejudice to filing one or more claims having similar subject matter. Reconsideration is respectfully requested. No new matter is added by this Reply.

Claim Rejections - 35 U.S.C. § 112

The Examiner rejects claim 10 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regards as their invention. The Examiner claims that, “pupil dilation would not be measured with a fingerprint sensor, since the pupil is of course located in the eye. Also what a fingerprint sensor has to do with motion is not clear” (page 2). Applicants respectfully traverse this rejection. However, to expedite prosecution, Applicants amend claim 10 to clarify the claim.

Claim Rejections – 35 U.S.C. § 102(e)

The Examiner rejects claims 1-8, 11-14, 16-18, 20, 22-30, 35-40 and 43-47 under 35 U.S.C. § 102(e) as being anticipated by Hoshino, U.S. Patent No. 6,636,620, (“Hoshino”). Applicants respectfully traverse these rejections.

In general, Hoshino discloses a method and system for authenticating personal information using fingerprint technology. Hoshino teaches proffering fingerprints at client terminals (col. 4, lines 30-44), wherein the terminals “compare information related to a sensed fingerprint with stored fingerprint information on the IC card,” wherein the stored fingerprint information is associated with personal information (col. 4, 45-54). However, Hoshino limits such personal information to information related to an ID number and a fingerprint of a user associated with only one account (col. 1, lines 33-42; col. 4, lines 20-23; col. 4, lines 40-43, col. 6, lines 32-36). As such, Hoshino does not disclose or suggest at least “said registered fingerprint sample is primarily associated with a first user account and secondarily associated with a second user account, and wherein said second user account is different than said first user account,” as similarly recited by independent claims 1, 22, and 35.

Moreover, Applicants assert that Hoshino teaches away from the use of an IC card that performs both biometric verification and payment because Hoshino states that its only purpose is

“to provide a small-sized personal identification authenticating system for preventing unauthorized individuals from accessing a computer” (col. 2, lines 50–52). The Examiner also states that Hoshino's discussion of access to transaction systems focuses on “client-server systems, such as ATMs” (page 3). Hoshino's discussion of ATMs involves providing “a personal identification authenticating system for use in a terminal that can request both an exclusive service and open service to a user” (col. 2, lines 42-49). As such, Hoshino is limited to the end goal of accessing a computer or ATM terminal. Hoshino does not teach or suggest at least “[a] smartcard transaction system configured with a biometric security device...to facilitate a smartcard payment transaction,” as similarly recited by independent claims 1, 22 and 35.

Regarding claim 2, the Examiner asserts that “[t]here are also dozens of known patents which teach a fingerprint sensor on the card itself” (page 5). However, the Examiner does not cite any particular patent. *See* MPEP § 707.05. Accordingly, Applicants respectfully request that Examiner provide a specific patent and section that discloses this item.

Applicants have canceled claims 11 and 13-14 without prejudice or disclaimer, so the rejections related to claims 11 and 13-14 are now moot. Claims 2-8, 12, 16-18, 23-27, 29-30, 36-40, and 44-47 variously depend from independent claims 1, 22 and 35. Therefore, Applicants assert that claims 2-8, 12, 16-18, 23-27, 29-30, 36-40 and 44-47 are differentiated from the cited reference at least for the same reasons as set forth above, in addition to their own respective features.

Claim Rejections – 35 U.S.C. § 103(a)

The Examiner additionally rejects claims 9, 10, 19, 21, 31-34, 41 and 42 under 35 U.S.C. § 103(a) as being unpatentable over Hoshino as applied to claim 1 above. The Examiner notes that, with respect to claims 9 and 31, Hoshino discusses that ridge features are “generally common among detected fingerprints” (page 8) and the Examiner cites Kamei, U.S. Patent No. 5,901,239 (“Kamei”), as an example of a patent that “teaches bifurcation and other [fingerprint] features” (page 8). Regarding claims 10, 32, and 42, the Examiner states that “the claimed features are common among fingerprint sensors.” The Examiner cites Tuli, U.S. Patent No 5,942,761 (“Tuli”), for teaching detection of body heat in association with fingerprints. Applicants respectfully transverse this rejection.

Claims 9, 10, 19, 21, 31-34, 41 and 42 variously depend from independent claims 1, 22 and 35. Kamei generally discloses a skin pattern classification system that extracts ridge line

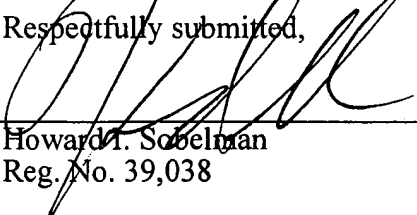
data and valley line data from image data of a skin pattern. Tuli generally discloses a fingerprint reading device capable of extracting and accurately reproducing a ridge pattern on the skin of a fingertip. Kamei nor Tuli disclose or suggest different user accounts or a biometric device to facilitate a transaction. As such, neither Hoshino, Kamei, Tuli, nor any combination thereof, disclose or suggest at least "said registered fingerprint sample is primarily associated with a first user account and secondarily associated with a second user account, and wherein said second user account is different than said first user account," or "[a] smartcard transaction system configured with a biometric security device...to facilitate a smartcard payment transaction," as similarly recited by independent claims 1, 22 and 35.

Finally, in a phone message left on Applicants' attorney's voicemail, the Examiner additionally rejected claim 15 under 35 U.S.C. § 103(a) as being anticipated by Maritzen et al., U.S. Patent Application No. 2002/0191816 ("Maritzen"). Applicants respectfully traverse this rejection.

Maritzen generally discloses a system and method for entering information through biometric identifiers, wherein each biometric identifier is associated with a different account. (Figure 6A). However, Maritzen is limited to one account for each different biometric identifier and does not disclose more than one account with a single biometric identifier. As such, Maritzen does not disclose or suggest at least "said registered fingerprint sample is primarily associated with a first user account and secondarily associated with a second user account" as recited in independent claim 1. Claim 15 directly depends from independent claim 1 and contains all the elements thereof. Therefore, Applicants respectfully submit that claim 15 is differentiated from the cited reference at least for the same reasons as set forth above, in addition to its own respective features.

Applicants submit that the pending claims are in condition for allowance. **The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. 19-2814.** Applicants invite the Examiner to telephone the undersigned if the Examiner has any questions regarding this Reply or the present application in general.

Dated: August 5, 2005

Respectfully submitted,

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